

REMARKS

In the office action dated January 14, 2005, claims 1-29 were pending. Claims 22-29 were withdrawn as being directed to a non-elected invention, and have been cancelled in this response without prejudice to pursuit in a divisional application. Claims 1-21 stand rejected. Reconsideration of the present application as amended and including claims 1-21 in view of the remarks that follow is respectfully requested.

Claim 16 was rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 4,059,115 to Jumashev et al. "[A]n invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim." Richardson v. Suzuki Motor Co. Ltd., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The claims must not be treated as "mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning." Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al., 730 F.2d 1452, 1459, 221 USPQ 481, 486 (Fed. Cir. 1984). As a result, a reference that coincidentally lists features of a claim without describing the claimed arrangement, relationship, and organization of such features cannot anticipate.

Jumashev et al. discloses a tensioning device that includes a hollow cutter 4 with a cutting edge 5 and a knife 7 in cutter 4. As shown in Fig. 15, cutter 4 is advanced into the adjacent vertebrae while knife 7 is in the disc space. However, knife 7 does not limit distal advancement of cutter 4 since, as shown in Fig. 16, knife 7 is rotated within cutter 4 to remove a core between the vertebrae. To prevent over insertion of knife 7 and cutter 4 into the spinal canal, a limit flange 19 inside cutter 4 is provided. However, this limit flange 19 is not a distractor nor is it position in the disc space. Rather, flange 19 abuts the anterior faces of the adjacent vertebrae. *See* col. 5, lines 27-56.

Claim 1 recites a method that includes "inserting a body portion of a distractor into the spinal disc space; advancing a cutting instrument over the body portion into the spinal disc space; and limiting advancement of the cutting instrument into the spinal disc space by contacting the cutting instrument with a distal end wall of the body portion." As discussed above, Jumashev et al. does not disclose limiting insertion of the cutting

instrument by contacting the distal end of the distractor. Since there is no disclosure of at least these features in claim 16, Jumashev et al. cannot anticipate claim 16 and withdrawal of this basis of the rejection is respectfully requested.

Claims 1-8 and 10-21 were rejected under the judicially created doctrine of obviousness type double patenting over claims 26-29 of U.S. Patent No. 6,599,291. Furthermore, claim 9 was rejected for obviousness type double patenting in view of claim 28 of the '291 patent and further in view of U.S. Patent Application Publication No. 2002/0156481 to Boyd et al. Enclosed herewith is a terminal disclaimer for the present application, which is commonly owned with and a child application of the '291 patent. Accordingly, withdrawal of this basis of the rejection is respectfully requested.

It was noted that with respect to claim 9 the office action refers to U.S. Patent No. 6,559,291. It is assumed that this was in error and that the same U.S. Patent No. 6,599,291 cited relative to claims 1-8 and 10-21 was intended to be cited against claim 9. If this assumption is incorrect, then clarification of the rejection is respectfully requested.

Examination of the present application as amended and including claims 1-21 in view of this response is respectfully requested. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the present application.

Respectfully submitted:



Douglas A. Collier
Reg. No. 43,556
Krieg DeVault LLP
One Indiana Square, Suite 2800
Indianapolis, Indiana 46204-2079
Bus.: (317) 636-4341
Facsimile: (317) 636-1507